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09/903,717	07/13/2001	Anders Onshage	032927-012	9292

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EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,717

Applicant(s)

ONSHAGE ET AL.

Examiner

Ming Chow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 5-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US: 6529602).

Regarding claims 1, 5, 8 and 14, Walker et al teach a method and apparatus for recording telephone conversations users. Walker et al also teach on column 6 line 62-67 the audio vault sends a message requesting authorization to the second telecommunication device for the recording. The second telecommunication device responds authorization to the first telecommunication device by using the touch tone keys or with a voice command.

Walker et al teach on Fig. 1C party 1 inherently has a telecommunication terminal that reads on “first telecommunication device” and vault (recoding means which sends a message requesting authorization for the recording”) to perform the claimed feature including sending from first telecommunication device to a second telecommunication device a message requesting authorization for recording. However, Walker et al does not explicitly state that the telecommunication terminal used by party 1 (Fig. 1C) and the audio vault are a “device” (which

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is the claimed first telecommunication device includes an audio vault and a terminal with a microphone and a speaker) although Walker's telephone and vault perform the claimed features.

An "Official Notice" is taken that it is old and well known to one skilled in the art that a telecommunication device (example, a telephone set) equipped with a recording device function (see newly discovered prior art – Chamberlin et al; US: 4817127 to support the Examiner's statement, Chamberlin et al clearly teach a telecommunication terminal device, item 10 on Fig. 4, that includes a telephone module, item 18 Fig. 4, and two recording/playback modules, items 12 and 14 Fig. 4). Since naming two well known devices (telephone terminal and recording device) as one device has no patentability significance and it would have been obvious to one skilled in the art to modify Walker's system in a way that the vault and the telephone terminal are integrated as one device so that the recording device can be easily maintained and used by the user of the first telecommunication device.

Regarding "second telecommunications device comprises a speaker and a microphone", Walker teach on column 10 line 36-38 a touch tone telephone.

For claim 2, rejections as stated in claim 1 above apply.

Regarding "prohibiting said recording if a responding message giving said authorization is not received and recognized by said first telecommunications device in response to said requesting message", Walker et al teach on column 6 line 62-67 audio statement querying the second party "Do you agree to begin recording?" The second party may respond by using the touch tone keys or with a voice command and the response is interpreted as the initial request to start recording. Therefore, it is obvious when the authorization is not received (i.e. un-

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authorization touch tone key signal, or un-authorization voice command) the recording will not start.

Regarding claim 3, Walker et al teach on column 6 line 63-65 the requesting message is a voice message.

Regarding claims 6, 10 and 15, the system of Walker et al must advise the user of the first telecommunication device whether the authorization request is granted or not.

Regarding claim 7, regarding "said telephone conversation.....additional telecommunication device". Walker et al teach on column 5 line 23-25 embodiment for recording conference call.

Regarding claim 9, Walker et al teach on column 6 line 54-57, voice recognition processor.

Regarding claims 11 and 16, Walker et al teach on column 6 line 44-67 the authorization from the second party is received (reads on the claimed "stored") by the audio vault (the claimed "device").

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Regarding claim 12, Walker et al teach on column 12 line 50-54 the system could use triangulating cellular phone signals. It is obvious that the telephone devices taught by Walker et al include cellular telephones (the claimed "mobile telephone").

Regarding 13, rejections as stated in claim 1 above apply.

Regarding "respond automatically to a received message requesting authorization for the recording", Walker et al teach on column 6 line 57-67, the audio vault (the claimed "telecommunication device") automatically responds to the authorization request by sending a query to the second party.

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US: 6529602), and in view of Harman, Kim (US: 6278884) and Lee (US: 6526287).

All rejections as stated in claim 1 above apply.

Regarding the recording being performed under control of said first telecommunication device, Walker et al teach on column 7 line 1-2 the audio vault (the claimed "first telecommunication device" controls the recording).

Walker et al failed to teach "performing said recording, by circuit integrated in the first telecommunications device", Kim teaches on items 11, 44, 54, 22 Fig. 2 integrated circuitry for performing the recording.

Walker et al failed to teach "performing said recording, by an accessory attached to the first telecommunication device", Lee teaches on Fig. 4, column 1 line 64-67 a cellular phone

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with an attached accessory ("MP3 player" of Lee) to record sound from a mike and speaker mixer via a call processing part.

It would have been obvious to one skilled at the time the invention was made to modify Walker et al, Harman to have "performing said recording, by circuit integrated in the first telecommunications device or by an accessory attached to the first telecommunication device" as taught by Kim and Lee such that the modified system of Walker et al, Harman would be able to support the recording either by integrated circuit or by an accessory to the system users.

Response to Arguments

3. Applicant's arguments filed on 4/19/04 have been fully considered but they are not persuasive.

- i) Applicant argues, on pages 2-3, regarding establishing a *prima facie* case of obviousness. As rejections stated above, the Examiner has followed MPEP 2142, 2143 in establishing a *prima facie* case of obviousness for rejection. The first of three basic requirements states "suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art". As to the second requirement, the reasonable success can also be expected as stated above. For example,

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rejection to claims 1, 5, 8, 14, Walker et al is silent on “party 1 telecommunication device and the vault are collocated”. Further, Chamberlin et al teach the recording module is attached (collocated) to the telephone for recording telephone conversation. Therefore, the success is more than just “reasonable” but is absolutely expected. Regarding the third requirement, all limitations as claimed have been rejected as stated above. In addition, MPEP 2143.01 states “obviousness can only be established by combining or modifying the teachings of prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art”. The Examiner has withdrawn the rejection based on Walker et al in view of Harman as stated in the previous Office Action. However, the Examiner remains the rejection based on Walker et al and the “Office Notice” as stated in claim1 rejection. Therefore, no new grounds of rejection is introduced.

- ii) Overall, the Examiner remains the same grounds of rejection as stated in the previous Office Action and, therefore, makes this Office Action final.

Conclusion

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communication from the examiner should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any inquiry of a general nature or relating to the status of this application or proceeding should be mailed to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

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Ming Chow

A handwritten signature in cursive script, enclosed within a hand-drawn circle. The signature appears to be 'Ming Chow'.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in cursive script, consisting of a large, stylized 'F' followed by a long horizontal line.